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EXAMINER
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ART UNIT	PAPER NUMBER
2157	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	09/929,995	TERNULLO ET AL.
	Examiner	Art Unit	
	SARGON N. NANO	2157	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on 8/10/2007.

2a) ☒ This action is **FINAL**.　　　2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1 , 3 - 20, 22- 24, 29 - 45, 47</u> is/are pending in the application.

　　4a) Of the above claim(s) <u>2, 21, 42 , 44, 46</u> is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1, 3 - 20, 22- 24, 29 - 45, 47</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

　　Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　　a) ☐ All　b) ☐ Some * c) ☐ None of:

　　　1. ☐ Certified copies of the priority documents have been received.

　　　2. ☐ Certified copies of the priority documents have been received in Application No. _____.

　　　3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

　　* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
　　Paper No(s)/Mail Date <u>1 /08,, 8/08</u>.

4) ☐ Interview Summary (PTO-413)
　　Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

Response to Amendment

1. This office action is responsive to amendment filed on May 16, 2008. Claims 1, 19,

29 are amended. Claims 1, 3 – 20, 22 – 24, 29 – 42, 45 and 47 are pending

examination.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite

for failing to particularly point out and distinctly claim the subject matter which applicant

regards as the invention.

The term " substantially" in claim 1 is a relative term which renders the claim

indefinite. The term "sustantially" is not defined by the claim, the specification does not

provide a standard for ascertaining the requisite degree, and one of ordinary skill in the

art would not be reasonably apprised of the scope of the invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2.   Claims 1, 3 – 20, 22 – 24, 29 – 42 and 45 are rejected under 35 U.S.C. 103(a)

as being unpatentable over Hendrey et al. U. S. Patent No. 6,647,269 (referred to

hereafter as Hendrey) in view Camaisa et al U. S. Patent No. 5,845,263 (referred to

hereafter as (Camaisa) in further view of official notice.

As to claim 1, Hendrey teaches a method for utilizing an advertisement for a

service for accessing a service, the service being relevant to a location to a client device

at the location, said method comprising the steps of:

formatting, outside the client device, substantially all unsolicited advertising

information from the advertisement, the unsolicited advertising information including

(see col. 2 Lines 14 – 22, Hendrey discloses an advertisement received by a mobile

device):

service information indicating the purpose of the advertisement (see col. 2 lines

14 – 22 Hendrey discloses mobile device enters the area of a corresponding to a certain

business);

data entry information indicating purchasing options based on the purpose (see

col. 2 lines 30 – 40 Hendrey discloses a user of a mobile device is associated with a

purchase at a store) ; and

contact information containing instructions for enabling the client device to

communicate, with the service; forming an advertising signal containing the unsolicited

advertising information (see col. 2 line 57 – col. 3 line 6, Hendrey discloses system

delivering advertisement to a mobile device) ;

propagating the advertising signal from a transmitter to the client device within

the location; receiving the advertising signal at the client device (see col. 2 line 57 – col.

3 line 6, Hendrey discloses system delivering advertisement to a mobile device);

decoding the advertising signal to extract the unsolicited advertising

information(see col. 2 line 57 – col. 3 line 6, Hendrey discloses system delivering

advertisement to a mobile device); displaying the unsolicited advertising information to

a user of the client device(see col. 2 line 57 – col. 3 line 6, Hendrey discloses system

delivering advertisement to a mobile device); and

Hendrey teaches the invention as mentioned above. Hendrey does not explicitly

teach "determining, by the client device, a response to the advertising signal, based on

the unsolicited advertising information". However, Camaisa teaches a portable

interactive visual ordering system where the system is utilized to facilitate ordering

menu items by a consumer. It would have been obvious for one of the ordinary skill in

the art at the time of the invention was made to incorporate Camaisa's interactive

ordering system in Hendrey's invention to allow the a customer purchase a product as

soon as possible without waiting in line (see Camaisa col.1 lines 26 – 33 and abstract).

Camaisa and Hendrey fail to explicitly teach the use of XML elements, However,

official notice is taken that it would have been obvious for one of the ordinary skill in the

art at the time of the invention was made to modify the above mentioned invention by

using the markup languages such as XML to synchronize data between wireless

devices and corporate databases.

As to claim, 3 Hendrey and Camaisa teach the method of claim 1 further comprising the steps of:

selecting the service based on the unsolicited advertising information and the response (see col. 2 line 57 – col. 3 line 6);

communicatively coupling the client device with the selected service as a result of said step of selecting(see col. 2 line 57 – col. 3 line 6); and

communicating the selection and the response to the selected service(see col. 2 line 57 – col. 3 line 6).

As to claim 4, Hendrey and Camaisa teach the method of claim 3 further comprising the step of constructing a user interface for allowing the user to communicate with the client device (see col. 2 line 57 – col. 3 line 25).

As to claim 5, Hendrey and Camaisa teach the method of claim 4 further comprising the step of receiving user inputs in response to the unsolicited advertising information (see col. 2line 57 – col. 3 line 6).

As to claim 6, Hendrey and Camaisa teach the method of claim 5 further comprising the step of formatting the user inputs, the response, and a portion of the unsolicited advertising information into a user reply, the user reply for making the user inputs available to the service (see col. 2line 57 – col. 3 line 6).

As to claim 7, Hendrey and Camaisa teach the method of claim 6 wherein the user reply is received at the transmitter (see col. 2line 57 – col. 3 line 6).

As to claim 8, Hendrey and Camaisa teach the method of claim 7 wherein the user reply is received as a wireless signal from the client device (see col. 2line 57 – col. 3 line 6).

As to claim 9, Hendrey and Camaisa teach the method of claim 7 wherein the user reply is received at the transmitter using a communication interface providing electromechanical contact between the client device and the transmitter (see col. 2line 57 – col. 3 line 6).

As to claim 10, Hendrey and Camaisa teach the method of claim 9 further comprising the step of receiving a service response from the transmitter, the service response including, executable code for allowing the client device to interact with the service (see col. 2 line 57 –col. 3 line 6).

As to claim 11, Hendrey and Camaisa teach the method of claim 6 wherein the user reply is sent directly from the client device to received at a point-of-presence (POP) (see col. 2 line 14 – 29).

As to claim 12, Hendrey and Camaisa teach the method of claim 11 wherein the user reply is received over a personal digital assistant (PDA) interface providing electromechanical contact between the client device and the POP (see col. 2 line 57 – col. 3 line 6).

As to claim13, Hendrey and Camaisa teach the method of claim 12 further comprising the step of receiving a service response from the POP, the service response including executable code for allowing the client device to interact with the service (see col. 2 line 57 –col. 3 line 6).

As to claim 14, Hendrey and Camaisa teach the method of claim 1 wherein the advertisement is propagated as an optical signal through air (see col. 3 lines 9 – 26).

As to claim 15, Hendrey and Camaisa teach the method of claim 14 wherein the optical signal has a wavelength in the range of 850 nanometers to 1250 nanometers (see col. 3 lines 9 – 26).

As to claim16, Hendrey and Camaisa teach the method of claim 15 wherein the transmitter receives the advertisement over an Internet (see col. 3 lines 9 – 26).

As to claim 17, Hendrey and Camaisa teach the method of claim 15 wherein the transmitter receives the advertisement over a fiber optic network (see col. 3 lines 9 – 26).

As to claim 18, Hendrey and Camaisa teach the method of claim 1 wherein the client device is a personal digital assistant (PDA) (see col. 3 lines 9 – 26).

As to claim 19, Hendrey and Camaisa teach a method for conveying unsolicited information comprising the steps of:

preparing the unsolicited information by a service including: service information indicating the purpose of the information (see col. 2 lines 14 – 22);

data entry information indicating purchasing options based on the purpose(see col. 2 lines 14 – 22); and

contact information containing instructions for enabling the client device to communicate with the service(see col. 2 line 57 – col. 3 line 6);

receiving the unsolicited information from the service into a transmitter outside the client device having a link layer(see col. 2 lines 14 – 22);

formatting all the unsolicited information into a standard form in the transmitter

for transmission to a client device operating within a context associated with the

transmitter(see col. Lines 14 – 22); and

 conveying the unsolicited information from the transmitter to the client device

over a communication medium (see col. 2 line 57 – col. 3 line 6).

As to claim 20, Hendrey and Camaisa teach the method of claim 19 wherein the

unsolicited information is comprised of an XML element. Camaisa and Hendrey fail to

explicitly teach the use of XML elements, However, official notice is taken that it would

have been obvious for one of the ordinary skill in the art at the time of the invention was

made to modify Hendrey's invention by using the markup languages such as XML to

synchronize data between wireless devices and corporate databases.

As to claim 22, Hendrey and Camaisa teach the method of claim 19 wherein the

unsolicited information is conveyed from the transmitter as a diffuse infrared signal (see

col. 3 lines 9 – 25).

As to claim 23, Hendrey and Camaisa teach the method of claim 22 wherein the

diffuse infrared signal has a wavelength in the range of substantially 850 nanometers to

1250 nanometers (see col. 3 lines 9 – 26).

As to claim 24, Hendrey and Camaisa teach the method of claim 19 wherein the

client device includes a client device physical layer and a client device link layer

compatible with the link layer in the transmitter (see col. 2 line 57 – col. 3 line 6).

receiving the advertisement by the executable code in the transmitter from a

service provider about a service offered by the service provider(see col. Lines 14 – 22);

formatting the advertisement by the executable code in the transmitter for transmission to the client device operating within a coverage area of the transmitter(see col. Lines 14 – 22); and

conveying the advertisement by the executable code in the transmitter from the transmitter to the client device over a communication medium(see col. 2 line 57 – col. 3 line 6).

As to claim 30, Weiss teaches the method of claim 29 wherein the advertisement is comprised of an XML element. Camaisa and Hendrey fail to explicitly teach the use of XML elements, However, official notice is taken that it would have been obvious for one of the ordinary skill in the art at the time of the invention was made to modify Hendrey's invention by using the markup languages such as XML to synchronize data between wireless devices and corporate databases.

As to claim 31, Hendrey and Camaisa teach the method of claim 30 wherein the advertisement further comprises:

information enabling a user of the client device to make a decision about the service provider, the decision being based on the service information; data entry information informing the user about utilizing a service offered by the service provider; and contact information containing instructions for enabling the client device to communicate with the service provider (see col. 4 lines 46 – 55).

As to claim 32, Hendrey and Camaisa teach the method of claim 29 wherein the advertisement is conveyed from the transmitter as a diffuse infrared signal (see col. 3 lines 9 – 26).

As to claim 33 Hendrey and Camaisa teach the method of claim 32 wherein the diffuse infrared signal has a wavelength in the range of   850 nanometers to 1250 nanometers (see col. 3 lines 9 – 26).

As to claim 34, Hendrey and Camaisa teach the method of claim 33 wherein the diffuse infrared signal is generated by modulating an electric light (see col. 3 lines 9 – 26).

As to claim 35, Hendry teaches a method of utilizing executable code in a client device receiving an unsolicited, formatted advertisement from a transmitter located outside the client device, said method comprising the steps of:

receiving the unsolicited, formatted advertisement from an infrared communication signal conveyed from the transmitter, wherein the transmitter formatted the advertisement, and arriving at a communication interface associated with the client device, the unsolicited, formatted advertisement containing at least a portion of a service offered by a service provider (see col. Lines 14 – 22, Hendrey discloses an advertisement received by a mobile device);

decoding, the client device, the unsolicited, formatted advertisement to extract information contained therein(see col. Lines 14 – 22, Hendrey discloses an advertisement received by a mobile device);

relating, by the client device, the information to user-specific data in the client device; and displaying, by the client device, the information related to the user-specific data to a user of the client device(see col. Lines 14 – 22, Hendrey discloses an advertisement received by a mobile device).

As to claim 36, Weiss teaches the method of claim 35 wherein said unsolicited,

formatted advertisement is comprised of an XML element. Camaisa and Hendrey fail

to explicitly teach the use of XML elements, However, official notice is taken that it

would have been obvious for one of the ordinary skill in the art at the time of the

invention was made to modify Hendrey's invention by using the markup languages such

as XML to synchronize data between wireless devices and corporate databases.

As to claim 37, Hendrey and Camaisa teach the method of claim 36 wherein the

unsolicited, formatted advertisement further comprises: service information enabling the

user to make a decision about the service, the decision based on the service

information (see col.2 line 57 – col. 3 line 6);

data entry information informing the user about utilizing the service; and contact

information containing instructions enabling the client device to communicate with the

service provider (see col.2 line 57 – col. 3 line 6).

As to claim 38, Hendrey and Camaisa teach the method of claim 37 wherein the

transmitter includes an emitter link layer (see col.2 line 57 – col. 3 line 6).

As to claim 39, Hendrey and Camaisa teach the method of claim 38 wherein the

client includes a client device link layer (see col.2 line 57 – col. 3 line 6).

As to claim 40, Hendrey and Camaisa teach the method of claim 39 wherein the

emitter link layer is compatible with the client device link layer (see col.2 line 57 – col. 3

line 6).

As to claim 41, Hendrey and Camaisa teach the method of claim 40 wherein the

information about the service is displayed to the user if the client device is running a

plug-in cooperatively associated with the service (see col. 3 lines 17 – 33).

As to claim 42, Hendrey and Camaisa teach the method of claim 41 wherein the

plug-in further comprises information about a preference of the user (see col. 3 lines 17

– 33).

As to claim 45, Hendrey and Camaisa teach the method of claim 19 wherein the

unsolicited information is conveyed from the transmitter as a radio frequency (RF) signal

(see col. 3 lines 9 – 26). The following is a quotation of 35 U.S.C. 103(a) which forms

the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

3.   Claim 47 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hendrey

et al. U. S. Patent No. 6,647,269 (referred to hereafter as Hendrey) in view of Camaisa

et al. U. S. Patent No.5,845,263 (referred to hereafter as Camaisa) and in further view

of Kahn at al U.S Patent No. (referred to hereafter as Kahn)..

As to claim 47, Hendrey and Camaisa teach a method for determining a user

response to predetermined information relevant to a client device at the location, said

method comprising the steps of:

formatting , outside the client device, the predetermined information including :

service information indicating the purpose of the service (see col. 2 lines 14 – 22)

data entry information indicating options based on the purpose (see col. 2 lines 30 – 40); and

contact information enabling the client to communicate with the service(see col. 2 line 57 – col. 3 line 6);

forming a signal containing the predetermined information(see col. 2 line 57 – col. 3 line 6);

propagating a signal containing from the transmitter to the client device within the location(see col. 2 line 57 – col. 3 line 6);

receiving the signal at the client device(see col. 2 line 57 – col. 3 line 6,;

extracting the predetermined information; and determining , by the client device , a user response to the predetermined information from user eye movement (see col. 2 line 57 – col. 3 line 6). Hendry teaches the invention as mentioned above. Hendrey and Camaisa fail to explicitly teach the user response in the form of eye movement, However Kahn teaches a visual communication apparatus where a user makes a selection by eye movement. It would have been obvious to one of the ordinary skill in the art at the time of the invention was made to incorporate the visual selection feature in the above mentioned invention to provide visual communication for people who can not or prefer not to use their hands to operate manual interface device (see Kahn col. 1 lines 12 – 20).

Response to Arguments

4.   In the remarks applicant argue in substance that:

A) Hendrey does not disclose formatting to XML.

In response to A), Hendrey discloses a method and system for analyzing advertisements delivered to a mobile unit. Examiner contents that Hendrey does not explicitly disclose the use of XML elements in the advertisements received by the mobile unit of a user. However, to remedy this deficiency, an official notice is taken since Extensible Markup languages are old and well known in the art as evidenced by Lewontin U.S. Publication No. 2002/0087596 , where browsers and software for the World wide Web that deal with documents are marked in languages such as HTML, XML and WAP etc. Therefore the combination of Hendrey – Camaisa and Lewontin still meet the claimed limitation as presented in the application.

B) Camaisa teaches away from single formatting.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., single formatting) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

   C) Hendrey does not suggest or disclose the transmission of executable code to

        to Hendry's mobile unit because Hendrey limits the transmissions between the

        tracking system and the mobile unit to 'data" .

        In response to C). Hendrey's executable codes are inherently

   included in Information being transferred in the telecommunication system. Hendrey

explicitly discloses all modalities of data transfer between the mobile device and the

telecommunication system (see Hendrey col. 8 line 64 – col.9 line 22).   Therefore the

disclosure of Hendry's many types of data or anything that can be transferred over a

telecommunication system meets the scope limitation of the claimed limitation.

5.   Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

        A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SARGON N. NANO whose telephone number is (571)272-4007. The examiner can normally be reached on 8 hour.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sargon Nano
Sept. 14, 2008

/Ario Etienne/
Supervisory Patent Examiner, Art Unit 2157